

REMARKS

I. Oath/Declaration

In response to the Examiner's request that the information on the Declaration be typed for the Office, an Inventor Information Sheet is attached.

II. Notice of References Cited

The Examiner cited "Using the SNAP Development Environment," by Template Software and "Using the Web Component," by Template Software in the Office Action. The two references, however, do not appear on the Notice of References Cited. Accordingly, Applicants respectfully request that the Examiner list the two references and any other references published by the Template Software cited in the Office Action on the Notice of References Cited.

III. Regarding the Office Action

In the Office Action mailed September 21, 2006, the Examiner rejected claims 1-9 under 35 U.S.C. § 101 as non-statutory subject matter; rejected claims 1, 3-15, 17-18, and 20 under 35 U.S.C. § 102(b) as being unpatentable over SNAP ("Using the SNAP Development Environment," by Template Software) and WEB ("Using the Web Component," by Template Software); and rejected claims 2, 16, and 19 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as being unpatentable over the commercial product line by Template Software in view of Development Tools. Based on the following remarks, Applicants respectfully traverse the rejections of the pending claims.

A. Rejections of Claims 1-9 Under 35 U.S.C. § 101

The Examiner asserted that claims 1-9 are directed to non-statutory subject matter because "the claims are directed to a form of energy which at present the office

feels does not fall into a category of invention.” (OA at p.2.) The Examiner relied on the United States Patent and Trademark Office policy (“Policy”) to support his assertion.

Applicants respectfully disagree with the Examiner’s interpretation of the claims.

Applicants, however, in an effort to advance prosecution, have amended independent claim 1 to more appropriately define the invention.

“35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and composition of matter.” (Policy at p.12.) Machines, manufactures and compositions of matter “define ‘things’ or ‘products.’” (Policy at p.12.) The amended claim 1 recites a computer program product, tangibly embodied in a storage device. Claims 2-3 depend from claim 1, claims 4 and 6-8 depend from claim 3, claim 5 depends from claim 4, and claim 9 depends from claim 8. As such, claims 1-9 are directed to statutory subject matter that falls within the scope of the four statutory categories. Accordingly, Applicants respectfully request that the rejection of claims 1-9 under 35 U.S.C. § 101 be withdrawn.

B. Rejections of Claims 1, 3-15, 17-18, and 20 Under 35 U.S.C. § 102(b)

The Examiner asserted that because the SNAP programming language and the Web component “work together, they constitute a single reference and can be used as the basis for a rejection based on” anticipation under 35 U.S.C. § 102(b). (OA at p.4-5.) Applicants respectfully disagree.

The Examiner’s assertion is not supported by the current case law of the Federal Circuit. “An ‘*anticipating*’ reference must describe all of the elements and limitations of the claim *in a single reference*, and enable one skill in the field of the invention to make

and use the claimed invention.” Merck & Co. v. Teva Pharms. USA, Inc., 347 F.3d 1367, 1372 (Fed. Cir. 2003). “Anticipation under 35 U.S.C. § 102 requires that a *single prior art reference* disclose each and every limitation of the claimed invention.” Moba B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1322 (Fed. Cir. 2003). Applicants respectfully disagree that two products can constitute a single reference for the purpose of anticipation under 35 U.S.C. § 102 merely because the two products “work together.”

Moreover, even if SNAP and WEB can be combined to constitute a single reference as asserted by the Examiner, the combination of SNAP and WEB fails to teach or suggest every claim element. In particular, the combination of SNAP and WEB fails to teach or suggest “the second design-time environment using a second programming model comprising one or more second model elements including models, views, and controller.” The Examiner asserted that WEB discloses the claim element. (OA at p.4.) WEB, however, discloses that “the Web Component libraries convert *SNAP application displays* to HTML documents or Java applets for display.” (WEB p.3-2). WEB further indicates that the Java applets generated by the Web Components are “static Java applets.” (WEB p.2-3). HTML is a markup language that supports only *views*. Static Java applets also support only *views* because static Java applets are used for displaying “charts, canvases, and topologies.” (WEB p.2-3). Accordingly, WEB fails to teach or disclose *models* or *controller* as second model elements, and therefore, fails to teach or disclose “the second design-time environment using a second programming model comprising one or more second model elements including models, views, and controller.”

Applicants respectfully submit that the combination of SNAP and WEB fails to support the rejection of independent claims 1, 10, 15, and 18. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of independent claims 1, 10, 15, and 18 and allow the claims.

Claim 3 depends from claim 1; claims 4 and 6-8 depend from claim 3; claim 5 depends from claim 4; claim 9 depends from claim 8; claims 11-14 depend from claim 10; claim 17 depends from claim 15; and claim 20 depends from claim 18. As explained above, SNAP and WEB do not support the rejection of claims 1, 10, 15, and 18 under § 102. Accordingly, SNAP and WEB do not support the rejection of claims 3-9, 11-14, 17, and 20 under § 102 for at least the same reasons set forth above in connection with claims 1, 10, 15, and 18. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 3-9, 11-14, 17, and 20 and allow the claims.

C. Rejections of Claims 2, 16, and 19 Under 35 U.S.C. §§ 102(b) or 103(a)

Claim 2 depends from claim 1, claim 16 depends from claim 15, and claim 19 depends from claim 18. Accordingly, claims 2, 16, and 19 are allowable at least by virtue of their dependence on allowable claims 1, 15, and 18, respectively. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 2, 16, and 19 and allow the claims.

(1) Rejections of Claims 2, 16, and 19 Under 35 U.S.C. § 102(b)

The Examiner rejected claims 2, 16, and 19 under 35 U.S.C. § 102(b) “as being unpatentable over the commercial product line by Template Software in view of Development Tools.” (OA p.8.) As explained above in connection with claims 1, 10, 15, and 18, the rejection of claims 2, 16, and 19 cannot be supported by the current case

law of the Federal Circuit. Two products cannot constitute a single reference for the purpose of anticipation under 35 U.S.C. § 102. Moreover, the combination of SNAP and WEB fails to teach or suggest every claim element. Accordingly, Applicants respectfully request that the rejection of claims 2, 16, and 19 under 35 U.S.C. § 102(b) be withdrawn.

(2) Rejections of Claims 2, 16, and 19 Under 35 U.S.C. § 103(a)

The Examiner, alternatively, rejected claims 2, 16, and 19 under 35 U.S.C. § 103(a) “as being unpatentable over the commercial product line by Template Software in view of Development Tools.” (OA p.8.) The Examiner asserted that “Template teaches the ability to build GUIs in SNAP to run as a local application and how to Web enable them with the product WEB which enables them to run in another environment.” (OA p.8.)

Applicants respectfully submit that no *prima facie* case of obviousness exists with respect to claim 2 for at least the reason that SNAP in view of WEB fails to teach or suggest every claim element. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim elements must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th ed., rev. 5, August 2006). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Each of these requirements must “be found in the prior art, not in Applicant’s discloser.” See M.P.E.P. § 2143 (8th ed., rev. 5, August 2006).

Claim 2 recites that “the second programming model is the SAP Web Dynpro programming model.” WEB teaches or suggests neither the SAP Web Dynpro programming model nor that “the second programming model is the SAP Web Dynpro programming model.” The Examiner, however, asserted the rejection based on the presumption that “the WEB tool of Templates meets the functional abilities of SAP Web Dynpro programming model.” (OA. p.8). In light of the SAP Web Dynpro programming model disclosed in the specification, Applicants respectfully disagree.

WEB discloses that “the Web Component libraries convert *SNAP application displays* to HTML documents or Java applets for display.” (WEB p.3-2). WEB further indicates that the Java applets generated by the Web Components are “static Java applets.” (WEB p.2-3). HTML is a markup language that supports only *views*. Static Java applets also support only *views* because static Java applets are used for displaying “charts, canvases, and topologies.” (WEB p.2-3). Although the Web Component libraries also “convert *end-user input* to the types of data and events that” SNAP applications expect, the part of SNAP applications that the Web Component libraries convert is limited to the applications’ *displays*. (WEB p.3-2). Because of these limitations, WEB specifically mentions that “certain features of SNAP do not operate over the web, because of the structure and limitations of HTML and of the various web browser programs.” (WEB p.2-3).

The SAP Web Dynpro programming model, however, supports the model-view-controller (MVC) programming model that the WEB tool of Templates fails to support. As a result, the conversion of the original design-time representation need not be limited

to its displays. Therefore, the presumption that the WEB tool of Templates meets the functional abilities of SAP Web Dynpro programming model is invalid.

As explained above, WEB fails to teach or suggest that “the second programming model is the SAP Web Dynpro programming model.” Therefore, WEB fails to cure the deficiency of SNAP as the Examiner asserted. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 2 and allow the claim.

Applicants respectfully submit that no *prima facie* case of obviousness exists with respect to claim 16 for at least the reason that SNAP in view of WEB fails to teach or suggest every claim element. For example, claim 16 recites that “the second programming model is the SAP Web Dynpro programming model.” As explained above in connection with claim 2, WEB fails to teach or suggest that “the second programming model is the SAP Web Dynpro programming model.” Therefore, WEB fails to cure the deficiency of SNAP as the Examiner asserted. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 16 and allow the claim.

Applicants respectfully submit that no *prima facie* case of obviousness exists with respect to claim 19 for at least the reason that SNAP in view of WEB fails to teach or suggest every claim element. For example, claim 19 recites that “the second programming model is the SAP Web Dynpro programming model.” As explained above in connection with claim 2, WEB fails to teach or suggest that “the second programming model is the SAP Web Dynpro programming model.” Therefore, WEB fails to cure the deficiency of SNAP as the Examiner asserted. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 19 and allow the claim.

In response to the Examiner's comments that the "product names not given patentable weight," Applicants respectfully submit that claims 2, 16, and 19 recite the product names not as patentable inventions but to further describe the claimed inventions under claims 2, 16, and 19.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

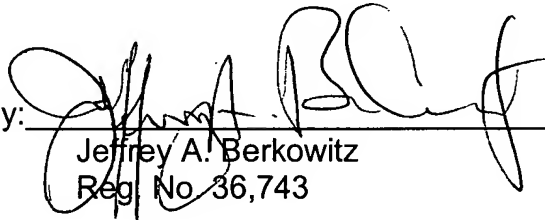
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 20, 2006

By:


Jeffrey A. Berkowitz
Reg. No 36,743

Attachment: Inventor Information Sheet